

**REMARKS**

This Amendment, submitted in response to the Office Action dated July 17, 2007, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration is respectfully requested.

The Examiner has indicated that in view of the Appeal Brief, the prosecution of the present application is reopened. Applicant kindly appreciates reconsideration of the application. The Examiner has indicated that the amendments filed on July 5, 2005, to the specification have been entered and the drawing(s) have been approved. The present office action raises new grounds of rejection; accordingly, this is a non-final office action.

Claims 1-6, 9, 11, 12, 15, 16, 19-22, and 27-31 are pending in the application. The Examiner objects to claims 2, 9, 19, 21, 29, and 31; claims 1-6, 9, 12, 15-16, 19-22, and 27-31 are rejected under 35 U.S.C. § 112, second paragraph; claims 1-2, 4, 9, 11-12, 15-16, 19-22, and 27-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Har (U.S. Patent No. 5,377,941); and claims 1-6, 9, 11, 12, 15, 16, 19-22, and 27-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Larkin (U.S. Patent No. 5,020,751).

**OBJECTION TO CLAIMS 2, 9, 19, 21, 29, AND 31**

Prior to Applicant's Appeal Brief, the Examiner rejected claims 2, 9, 19, 21, 29, and 31 under 35 U.S.C. § 112, second paragraph, for the exact same reasons that the Examiner now objects to these claims. However, now, the Examiner continues to maintain the same arguments with respect to the language of claims 2, 9, 19, 21, 29, and 31 after the Examiner elected to reopen prosecution of the application instead of

responding to Applicant's arguments when the issue was ready for review by the Board. However, now the Examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph and only "objects" to the claims for the same reason. By withdrawing the rejection under 35 U.S.C. § 112, second paragraph, the Examiner admits that the claim language satisfies the statutory requirements of 35 U.S.C. § 112, second paragraph. Accordingly, pursuant MPEP 2173.02, Applicant respectfully requests that the Examiner provide suggested language since Applicant disagrees with the Examiner *unsupported* assessment of these claims, particularly in view of Ex parte Miller, as explained in Applicant's Appeal Brief, which is incorporated by reference.

MPEP 2173.02 provides:

[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

Applicant can see no difference between the manner in which "the surface" and "storage unit" is recited in the present claims and the manner in which "theater seat" was recited *with approval* in Ex parte Miller. As explained in Applicant's Appeal Brief, in Ex parte Miller, the Examiner rejected a claim under 35 U.S.C. § 112, second paragraph, because the preamble recited "a theater seat hold-down device for maintaining a seat member" but the body of the claim recited "an elongated member . . . configured to engage at least one said seat member." The Examiner argued that "seat member" was functionally recited in the preamble but positively recited in the body and

therefore presented an inconsistency thereby justifying a rejection under 35 U.S.C. § 112, second paragraph. The Board reversed the Examiner's rejection, holding:

We do not agree with the examiner's position. The examiner apparently recognizes that the appellants, by setting forth functional recitations such as that of the hold-down device being "adapted" to engage the theater seat, have not positively recited the theater seat as a part of the claimed combination. Nevertheless, the examiner has taken the position that limitations such as that of the of hold-down device being "configured" (i.e, shaped) to engage a portion of a theater seat (previously set forth in the preamble), positively claim the theater seat as part of the claimed combination. **We must point out, however, that by reciting such language the appellants have merely defined the hold-down member in terms of attributes it must possess and, therefore, this language is also functional in character. That is, the appellants are merely defining the shape or structural configuration of the hold-down device in terms of its functional interrelationship with the theater seat when it is used in its intended manner, rather than positively reciting the theater seat as a part of the claimed combination.** Since we are not of the opinion that the theater seat has been positively set forth as a part of the claimed combination, we find no inconsistency between the preamble and the body of the claim as the examiner asserts. This being the case, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph.

(emphasis added).

In claims 2, 19, 21, and 29, the plate, ring piece, and cover are defined in terms of attributes they possess and in terms of their functional interrelationship with the surface, storage unit, and wastebasket when the plate, ring piece, and cover are used in their intended manner, rather than positively reciting the surface, storage unit, and wastebasket.

Accordingly, if the Examiner continues to maintain this objection, Applicant respectfully requests that the Examiner suggest language to his satisfaction for these claims.

Regarding claim 31, the Examiner objects to this claim, stating, "it is improper to use a dependent claim to expand the scope of the claim from subcombination to combination." The Examiner does not provide any explanation for this objection. Nevertheless, claim 31 is properly recited as a dependent claim. Claim 31 further limits claim 29 by adding an additional element to the claims, namely "a wastebasket."

### **35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION**

The Examiner rejected claims 1-6, 9, 12, 15-16, 19-22 and 27-31 under 35 U.S.C. § 112, second paragraph, on the ground that "it is not clear what direction is being defined/viewed as 'a first direction' [] or 'one direction' . . . [s]ince the view appears to be dependent upon location of the viewer only." However, Applicant's claims are not limited based on a location of the viewer and are not limited to a particular direction consistent with specification.

Regarding claims 1 and 12, the Examiner asserts that the recitation of "or" renders the claims indefinite; however, Applicant's use of the word "or" is permissible to further clarify the scope of Applicant's claim.

Further, regarding claim 12, the Examiner asserts that "the function for the means (in claim 12, line 3) has not been properly set forth." Claims 12 clearly recites function for both means element: (1) a first "means" *for securing*; and (2) a second "means" *for concealing*.

**35 U.S.C. § 102 REJECTION IN VIEW OF HAR**

Claims 1-2, 4, 9, 11-12, 15-16, 19-22, and 27-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Har. Applicant respectfully submits that Har does not disclose each and every element recited in these claims and, therefore, does not anticipate these claims. MPEP 2131. Furthermore, the various functional limitations in the claims set forth a function which the apparatus must be structurally capable of performing and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims. See, e.g., In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); MPEP 2173.05(g).

**Claims 1, 19-22 and 27-31**

Har does not disclose “a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit.” The Examiner contends that element 32 of Har is the cover recited in claim 1. First, element 32 is a top lid and not a cover as contemplated by the specification and recited in claim 1. Second, element 32 is not “sized to conceal” a storage unit, which the Examiner points to as element 27, which Har discloses is “a large central opening.” Col. 3, ll. 40-41. Applicant will assume that the Examiner intend to cite to element 30 (i.e. a waste or garbage bag). Har discloses:

The sink waste bag support device of this invention is generally indicated by the reference numeral 20 in FIG. 1. It is comprised of a support base 22 supported on a corner rim of sink 24. A support frame having a large central opening 27, is hingedly mounted upon the support base **to receive folded over top edges 28 of a waste or garbage bag 30** shown in dotted line over the top of the sink and support base and under the support frame in clamping relation. A hinged lid 32, generally congruent with the support frame is employed to cover the support frame and bag.

Col. 3, ll. 37-47. As shown in Fig. 1 and disclosed in the specification, element 30 (i.e., the alleged storage unit) is provided on the outside of support frame 26, and when the lid 32 is closed, even from a top view, it does not conceal element 30. As shown in Fig. 1, element 30 can extend beyond the outside border of support frame 26 and cover 32. Furthermore, because element 30 is not otherwise secured to prevent movement beyond the outside border, Har simply does not disclose or suggest concealing element 30.

Claim 19 recites that “the cover is sized and positioned on the holder to conceal **in whole** the storage unit from being viewed in a first direction.” Claim 23, a method claim, recites, “concealing **in whole** the storage unit when the storage unit is secured to the surface and viewed in a first direction.” Claims 20, which depend from claims 19, recites that the first direction is directed toward **a front elevation**. Har does not teach or suggest that the alleged cover (element 32) conceals **in whole** the storage unit when viewed from a first direction or a direction directed toward **a front elevation**. That is, Fig. 1 shows that element 30 can extend beyond the lid 32 and can be seen from a top view; Har does not teach or suggest that lid 32 conceals element 30. furthermore, Fig. 1 shows that element 30 can be completely seen from a front elevation. One of ordinary skill in the art understands that a “front elevation” is a view from the front and not a view from the top. See, e.g., U.S. Department of Commerce Patent and Trademark Office, A Guide To Filing A Design Patent Application at <http://www.uspto.gov/web/offices/pac/design/index.html>, retrieved on December 17, 2007 (“The Figure Descriptions indicate what each view of the drawings represents, i.e., front elevation, top plan, perspective view, etc.”); The American Heritage Dictionary of

the English Language, 4th ed. Boston: Houghton Mifflin, 2000 (defining elevation as “A scale drawing of the side, front, or rear of a structure.”). Thus, Har does not disclose that the lid 32 conceals **in whole** element 30; furthermore, Har does not disclose that the lid 32 conceals in whole element 30 **when viewed from a front elevation**.

Claim 21 recites, “the cover is sized and positioned on the holder to conceal **in whole the storage unit and holder** from being viewed in a first direction.” Claim 22, which depends from claim 21, recites that the first direction is directed toward a front elevation. Har does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction or a direction directed toward a front elevation. The Examiner indicates that the holder comprises elements 26, 22, and 50; However, the lid 32 does conceal in whole the alleged storage unit and holder when viewed from a first direction or a direction directed toward a front elevation.

Claim 27 recites, “a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.” Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. For the reasons discussed above, Har does not disclose these elements.

Claim 29 recites, “a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction.” Claims 30, which depends from claim 29, recites that the at least

one direction is directed toward a front elevation. Har does not teach or suggest that the alleged cover (element 32) includes “at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket.” The Examiner does not particularly point out the “at least one **surface**” of element 30 that at least one surface of element 32 is allegedly equivalent to or greater than. Also, for the reason discussed above, Har does not teach or suggest that “the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction” or a front elevation.

#### Claims 9

Claim 9 recites “a platform on which the storage unit sits, wherein the platform is attached to the plate”. The Examiner identifies elements 46, 48, and 26 as the platform and element 50 as the plate; however, a storage unit (i.e., allegedly element 30) does not sit on elements 46, 48, and 26.

#### Claims 11

Claim 11 recites “a storage unit” having a first and second mounting piece. The alleged storage unit in Har (i.e. element 30) does not have a first and second mounting piece. For this claim, the Examiner points to element 27, which Har discloses is “a large central opening.” Col. 3, ll. 40-41,

#### Claims 12

Regarding claim 12, Har does not disclose the corresponding structure or its equivalent for first means for securing and second means for concealing.



Based on at least the above, claims 1-2, 4, 9, 11-12, 15-16, 19-22, and 27-31 are patentable over Har.

### **35 U.S.C. § 102 REJECTION IN VIEW OF LARKIN**

Claims 1-6, 9, 11-12, 15-116, 19-22, and 27-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Larkin. Applicant respectfully submits that Larkin does not disclose each and every element recited in these claims and, therefore, does not anticipate these claims. MPEP 2131. Furthermore, the various functional limitations in the claims set forth a function which the apparatus must be structurally capable of performing and such a functional statement must be given full weight and may not be disregarded in evaluating the patentability of the claims. See, e.g., In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); MPEP 2173.05(g).

#### **Claims 1, 19-22 and 27-31**

Larkin does not disclose “a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit.” The Examiner contends that element 32 of Larkin is the cover recited in claim 1. First, element 32 is a top lid and not a cover as contemplated by the specification and recited in claim 1. Second, element 32 is not “sized to conceal” a storage unit, which the Examiner points to as element 50. More specifically, Larkin discloses:

In FIG. 1, the garbage bag 50 is **retained on the outside of the ring 12 by a cord 16**, preferably made of an elastic material. While the garbage bag 50 has been shown on the outside of the ring 12, greater strength may be obtained by **installing the garbage bag 50 on the inside of the ring and having the outer edge fall down on the outside of the ring**, so that the weight of material in the garbage bag 50 pulls the upper edge of the garbage bag 50 and the cord 16 up against the lip 14 which surrounds the ring 12.

Col. 2, ll. 11-22. Furthermore, the only disclosure in Larkin regarding the lid 32, provides:

The ring 12 is provided with a lid 32 attached to hinge 34, which may be bolted onto the arm 18 by bolts 36 passing into holes 38 of the arm 18. The lid 32 is particularly useful for situations where the garbage bag holder 10 is used indoors.

Col. 2, ll. 44-48, As shown in Figs. 1 and 2 and disclosed in the specification, element 50 (i.e., the allege storage unit) is provided on the outside of ring 12, and when the lid 32 is closed, even from a top view, it does not conceal element 50. As shown in Figs. 1 and 2, element 50 can extend beyond the outside border of the ring 12 and cover 32. Fig. 2 shows element 50 extending beyond the outside border; furthermore, because element 50 is not otherwise secured to prevent movement beyond the outside border, Larkin simply does not disclose or suggest concealing element 50.

Claim 19 recites that “the cover is sized and positioned on the holder to conceal **in whole** the storage unit from being viewed in a first direction.” Claim 23, a method claim, recites, “concealing **in whole** the storage unit when the storage unit is secured to the surface and viewed in a first direction.” Claims 20, which depend from claims 19, recites that the first direction is directed toward **a front elevation**. Larkin does not teach or suggest that the alleged cover (element 32) conceals **in whole** the storage unit when viewed from a first direction or a direction directed toward a **front elevation**. That is, Figs. 1 and 2 show that element 50 can extend beyond the lid 32 and can be seen from a top view; furthermore, Figs. 1 and 2 show that element 50 can be completely seen from a front elevation. One of ordinary skill in the art understands that a “front elevation” is a view from the front and not a view from the top. See, e.g., U.S.

Department of Commerce Patent and Trademark Office, A Guide To Filing A Design Patent Application at <http://www.uspto.gov/web/offices/pac/design/index.html>, retrieved on December 17, 2007 (“The Figure Descriptions indicate what each view of the drawings represents, i.e., front elevation, top plan, perspective view, etc.”); The American Heritage Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000 (defining elevation as “A scale drawing of the side, front, or rear of a structure.”). Thus, Larkin does not disclose that the lid 32 conceals **in whole** element 50; furthermore, Larkin does not disclose that the lid 32 conceals in whole element 50 **when viewed from a front elevation**.

Claim 21 recites, “the cover is sized and positioned on the holder to conceal **in whole** the **storage unit and holder** from being viewed in a first direction.” Claim 22, which depends from claim 21, recites that the first direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction or a direction directed toward a front elevation. The Examiner indicates that the holder comprises elements 14, 16, 18, and 60; however, the holder also includes elements 20, 26, and 42. See Larkin, col. 2, ll. 9-60, As shown in Figs. 1 and 2, the lid 32 does conceal in whole the alleged storage unit and holder when viewed from a first direction or a direction directed toward a front elevation.

Claim 27 recites, “a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.” Claims 28, which depends from claim 27, recites that the at least one

direction is directed toward a front elevation. For the reasons discussed above, Larkin does not disclose these elements.

Claim 29 recites, “a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction.” Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) includes “at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket.” The Examiner does not particularly point out the “at least one **surface**” of element 50 that at least one surface of element 32 is allegedly equivalent to or greater than. Also, for the reason discussed above, Larkin does not teach or suggest that “the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction” or a front elevation.

#### Claims 4 and 16

Claim 4 recites that “wherein the cover comprises a second mounting piece connected to the first mounting piece.” The Examiner identifies element 42 as the first mounting piece and element 36 as the second mounting piece. For Larkin to anticipate this claim, element 36 must be connected to element 42. As shown in Fig. 1, this is clearly not the case. To get around this missing element, the Examiner attempts to reason that element 36 is connected to element 42 via element 18; however, this is an improper construction of connected. This invention is not an electrical invention in

which “connected” generally is construed broadly; but, in the mechanical context, it’s unreasonable to assert that two pieces are connected when they are joined by a multiplied of intervening pieces as shown in Figs. 1 and 2. Furthermore, with respect to claim 16, which recites, “a second mounting piece structured to attach to the cover and first mounting piece”, Larkin does not disclose that element 36 is structured to attached to element 42.

#### Claims 9

Claim 9 recites “a platform on which the storage unit sits, wherein the platform is attached to the plate”. The Examiner identifies element 14 as the platform and element 60 as the plate; however, a storage unit (i.e., allegedly element 50) does not sit on element 14. Furthermore, as shown in Figs. 1 and 2, element 14 (the alleged platform) is not attached to element 60 (i.e., the alleged plate) as required by the claim.

#### Claim 11

Claim 11 recites “a storage unit” having a first and second mounting piece. The alleged storage unit in Larkin (i.e. element 50) does not have a first and second mounting piece. For this claim, the Examiner points to element 10, which is the entire structure disclosed. However, this is not a proper construction on the term “storage unit.”

#### Claim 12

Regarding claim 12, Larkin does not disclose the corresponding structure or its equivalent for first means for securing and second means for concealing.

Based on the above, claims 1-6 and 9-31 are patentable over Larkin.

**CONCLUSION**

Based on the above the claims are in condition for allowance and Applicant respectfully requests the Examiner to issue the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees.

Respectfully submitted,

  
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Dated: December 17, 2007